



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,572	02/17/2004	Krzysztof Antoni Zaklika	197-001-USP	9281
45346	7590	06/12/2009		
HENSLEY KIM & HOLZER, LLC				
1660 LINCOLN STREET, SUITE 3000				
DENVER, CO 80264				
EXAMINER				
DESIRE, GREGORY M				
ART UNIT		PAPER NUMBER		
2624				
MAIL DATE		DELIVERY MODE		
06/12/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/781,572

**Applicant(s)**

ZAKLIKA ET AL.

**Examiner**

Gregory M. Desire

**Art Unit**

2624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 and 45-51 is/are rejected.
- 7) ☒ Claim(s) 32-44 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s) Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s) Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communication filed 3/11/09.

***Response to Amendment***

2. The application is not ready for allowance. The examiner maintains the provisional non-statutory obviousness-type double patenting rejection. The examiner withdraws the 35 USC 101 because the claims do not fall within one of the four statutory categories or failing to be a qualifying transformation. However, a new 35 USC 101 is provided for claim 51 because the claims define a system and the specification indicates it may be embodied a pure software. Applicant's arguments filed 3/11/09 have been fully considered but they are not persuasive. Thus, examiner maintains the art rejection.
3. This action is a supplemental action. In the office action filed 5/26/09, examiner cites maintaining the non-statutory obviousness-type double patenting rejection. However, the rejection was not included in the office action. The supplemental includes the provisional non-statutory obviousness-type double patenting rejection.

***Response to Arguments***

1. Applicant argues (remarks page 9 lines 10-11) Hamburg does not disclose more than one particular area of a tip region defining more than one predefined color. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., one region with multiple distribution of pixel properties) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
2. Applicant argues Hamburg does not teach editing pixels of the image based on a first distribution of pixel property of pixels in a first area of the tip region and a second distribution of pixel property of pixels in the second area of the tip region. This argument is not persuasive because it is the position of the examiner Hamburg does teach editing based on the first and second distributions note col. 36-42 and 48-52, examiner interprets erasure and decontamination process as editing, based on color values for each pixels in the digital image, which may include a first and second color value,).
3. Applicant argues (page 9 last line) applicant can find no reference in Hamburg to multiple regions. This argument is not persuasive because Hamburg does

reference multiple region (note col. 6 lines 39-40, referring to a background color and foreground color, examiner interprets a referencing multiple regions a background and foreground).

4. Applicant argues (page 10 lines 18-20) no reference to a property distribution that outputs a fraction of all the pixel region of the tip profile that possesses a specific property value. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., property distribution that outputs a fraction of the pixels in a region) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
5. Applicant argues (page 10 lines 20-22) no reference in Hamburg to multiple color match functions applying to multiple tip regions of the tip profile In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., multiple color match functions applying to multiple regions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4-5, 26, 30-31 and 51 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, 7-9, 13 and 16-20 of copending Application No. 10/955,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because regarding independent claims 1, 26 and 51 of the instant application, copending claims 4 and 16 of the instant application fully discloses the limitations of the independent claims of the instant application. Regarding claims 4-5 and 30-31 of the instant application are similarly rejected by claims 7-9 and 16-19 of the copending application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claim 51 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 51 defines a "system".

However, while the preamble defines a "system", which would typically be indicative of an "apparatus", the body of the claim lacks definite structure indicative of a physical apparatus. Furthermore, the specification indicates that the invention may be embodied as pure software note specification page 35 lines 5-7 and page 36 lines 15-18. Therefore, the claim as a whole appears to be nothing more than a "system" of software elements, thus defining functional descriptive material per se.

Functional descriptive material may be statutory if it resides on a "computer-readable medium or computer-readable memory". The claim(s) indicated above lack structure, and do not define a computer readable medium and are thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests:

1. Amending the claim(s) to embody the program on "computer-readable medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory; or
2. Adding structure to the body of the claim that would clearly define a statutory apparatus.



Any amendment to the claim should be commensurate with its corresponding disclosure.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9, 20-34 and 45-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamburg (6,424,269).

Regarding claims 1, 26 and 51 Hamburg discloses,

Sampling pixels in a first region within a tool impression in a digital image to determine a first distribution of a pixel property of the pixels in the first region (note col. 6, lines 39-43, predefined color sampled, statistically derived);

Sampling pixels in a second region (column 7, lines 42-43: current: current color at the center of the brush) within the tool impressions to determine a second distribution of the pixel property of the pixels in the second region (column 6, lines 39-43: predefined color sampled, statistically derived; column 6, lines 43-49: predefined statistical profile for background or foreground colors); and

Editing at least one pixel within the tool impression based on the first and second distributions (note col. 6 lines 36-42 and 48-52, color match value are values for each

pixel in the digital image indicates the degree of matching based on the sampling of the two regions that is used erasure and decontamination process examiner interprets as editing).

Regarding claims 2 and 27 Hamburg discloses,

Altering an editable pixel property of the at least one pixel (note col. 7 lines 54-56, examiner interprets the possible erasure of pixels as altering procedure and property used for erasing is the editable pixel property of the pixel).

Regarding claims 3 and 28 Hamburg discloses,

Altering an editable pixel property of the at least one pixel, the editable pixel property being different that the sampled pixel property (note col. 8 lines 39-45, alpha value is the property erased, which is different from the color which is sampled pixel property).

Regarding claims 4 and 29 Hamburg discloses,

Wherein the first and second regions represent differently-located subdivisions of the tool impressions (note col. 7 lines 20-24)

Regarding claims 5 and 30 Hamburg discloses,

Editing the at least one pixel within the tool impression according to an edit profile based on the first and second distribution of the pixel property (column 7, lines 13-15; column 8, lines 20-25; figure 3b).

Regarding claims 6 and 31 Hamburg discloses,

Wherein the edit profile is determined by classifying the pixel properties as a function of pixel property differences (note figures 3a and 3b).

Regarding claims 7-8 and 32-33 Hamburg discloses,

Wherein the edit profile is determined by classifying the pixel properties into at least two edit classes, each edit class applying a different degree of editing effect (note fig. 3a 203 and fig. 3b 310).

Regarding claims 9 and 34 Hamburg disclose,

Wherein the edit profile is determined by classifying the pixel properties using blind signal separation

Regarding claims 20 and 45 Hamburg discloses,

Editing at least one pixel within each of the first region and the second region of the tool impression based on the first and second distribution of the pixel property (note col. 6 lines 36-42 and 48-52, color match value are values for each pixel in the digital image indicates the degree of matching based on the sampling of the two

regions that is used erasure and decontamination process examiner interprets as editing).

Regarding claims 21 and 46 Hamburg discloses,

Wherein the pixel property is a composite pixel property (note col. 5 lines 54-58).

Regarding claims 22 and 47 Hamburg discloses,

Wherein the pixel property is a multidimensional pixel property (note col. 5 lines 54-58).

Regarding claims 23 and 48 Hamburg discloses,

Determining a property value for each of a plurality of pixels within the first region (note col. 7 lines 25-27).

Regarding claims 24 and 49 Hamburg discloses,

Determining location and dimensions of the tool impression within the digital image (note col. 7 lines 18-30).

Regarding claims 25 and 50 Hamburg discloses,

Identifying the pixel in the first region within the tool impression of the digital image (note col. 7 lines 53-61); and

Identifying the pixels in the second region within the tool impression of the digital image (note col. 7 lines 53-61, identifying pixels in another region, shows multiple regions).

***Allowable Subject Matter***

3. Claims 35-44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. The following is a statement of reasons for the indication of allowable subject matter: The claims further limit the edit profile by classifying or categorizing using specific procedures.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bella C. Matthew can be reached on (571) 272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

G.D.

May 28, 2009

/Gregory M. Desire/  
Primary Examiner, Art Unit 2624